REMARKS

The office action of April 4, 2006 has been reviewed and its contents carefully noted. Reconsideration of this case, as amended, is requested. Claims 1 through 24 remain in this case, claims 16-24 being added and claims 1-4 and 12 being amended by this response. No new matter has been added. More specifically, claims 16 and 17 are fully supported by page 5, line 4 of the application, as filed. Claims 18 and 21-22 are fully supported by page 8, lines 14-15 of the application, as filed. Claims 19 and 23 are fully supported by page 5, lines 7-8 of the application, as filed. Claims 20 and 24 are fully supported by Figure 2, as filed.

The Applicant hereby submits a 1.132 declaration from Timothy J. Ledvina (Ledvina declaration), one of the inventors of U.S. Patent No. 5,779,582.

The numbered paragraphs below correspond to the numbered paragraphs in the Office Action.

Statement of the Substance of the Interview

The applicant's attorney, Meghan Van Leeuwen, had telephone interviews with the Examiner, Marcus Charles, on May 25, 2006 and June 29, 2006.

There were no exhibits shown or demonstrations exhibited during the telephonic interviews.

Claim 1 was discussed during the interview on May 25. No prior art was discussed during the interview on May 25. Claims 1 and 9-24 were discussed during the interview on June 29. Ferenc and Mott, prior art of record, were discussed during the interview on June 29.

During the interview on May 25, the Examiner stated that the 112 rejection was not overcome by the language proposed by the applicant's attorney, but suggested alternative language to overcome the rejection. The applicant's attorney agreed to amend the claim according to the Examiner's suggestion. The applicant's attorney and the Examiner also agreed to discuss the 102 and 103 rejections, as well as the new proposed claims, at a later date.

During the interview on June 29, the applicant's attorney and the Examiner discussed the 112 rejection again. The applicant's attorney and the examiner came to the same agreement as they had on May 25.

The applicant's attorney and the examiner discussed language for proposed claims dependent off of claim 1. The Examiner suggested language "wherein a space between each two guide pieces is wider than a width of each upraised element [guide piece]", but commented that Mott *et al.* may also show this in Fig. 12.

This led to a discussion of what Mott *et al.* taught in reference to the rejections of claims 9-15. The applicant's attorney explained that Mott *et al.* showed single guide rails on either side of the chain guide, not a plurality of solitary guide pieces on each side. While there are tapered segments, they are tapered segments of single, continuous guide rails. The Examiner asked for support for this statement, and the applicant's attorney pointed to Col. 3, lines 13-20, and the fact that all of the other figures show single tapered side rails. The applicant's attorney also pointed out that there is nothing in the description of Figs. 12 and 13 that support the Examiner's statement that there are multiple guide pieces on either side in Mott *et al.*

The Examiner stated that he would have to analyze Mott *et al.* more closely to determine what the reference taught. The applicant's attorney asked if a declaration from one of the Mott *et al.* inventors explaining what Mott *et al.* taught would be helpful for his review. The Examiner acknowledge that this would be helpful.

Rejection under 35 U.S.C. §112

2. Claims 2-4 and 12 were rejected under 35 U.S.C. 112, second paragraph, for being indefinite.

Claims 1, 3, 4, and 12 have been amended to overcome this rejection. Applicant believes that these amendments have fully addressed the Examiner's rejections, and the claims are now in condition for allowance. Reconsideration and withdrawal of the rejection are respectfully requested.

Rejection under 35 U.S.C. §102

4. Claims 1 and 4-8 were rejected under 35 U.S.C. 102(b) as being anticipated by Ferenc *et al.* (5,711,732). Applicant respectfully disagrees with the rejection.

As amended, claim 1 includes, in part, "ii) a plurality of solitary strip-shaped guide pieces having flat faces, wherein each of the solitary strip-shaped guide pieces is upraised from at least one of a first side edge portion of the chain sliding face and a second side edge portion of the chain sliding face opposite the first side edge portion, wherein the guide pieces are located along the chain sliding face and the flat faces of the guide pieces come in contact with and guide the chain".

Ferenc discloses a first exterior guide surface 34. "A first exterior guide surface 34 extends the length of the lateral side of the body between the first end 28 and the second end 30, and is relatively smooth such that it is adapted to engage and apply the necessary tension forces to the chain run 14a. The surface 34 is also flat in its width direction, but is slightly curved throughout its length". (col. 5, lines 29-34). The guide surface 34 is a prior art guide, which extends along the entire length of the shoe, similar to the guides discussed in the Background section of the present application and shown in Figure 5A of the present application.

Although not mentioned in Ferenc, the Examiner labeled two additional guide surfaces on either end of the body in Fig. 8 in a sketch he supplied with the office action. Assuming these are guide surfaces (which the Applicant does not concede), they are located on the opposite side of the body as the first exterior guide surface 34. Although smaller than the guide surface 34, these surfaces are also relatively long, extending along the length of the ends. The guide surface 34 in Ferenc has all of the flexural rigidity problems of the prior art. In addition, the Ferenc design does not have the same stiffness throughout the guide. Instead, a guide made in this manner would want to bend and tip the chain over.

The Examiner states that Ferenc discloses "a plurality of upraised-guide pieces extending from the sliding surface" (present office action dated April 4, 2006, page 3, lines 3-4). However, the Examiner does not address that the guide pieces in claim 1 are solitary strip-shaped guide pieces.

Ferenc does not disclose a plurality of solitary strip-shaped guide pieces upraised from a side edge portion of the chain sliding face having flat faces, wherein the guide pieces are located along the chain sliding face and the flat faces of the guide pieces come in contact with and guide the chain (emphasis added). Instead, Ferenc discloses a long exterior guide surface on one side of the body and may disclose two smaller guide surfaces, on the ends of the other side of the body. None of the guide surfaces are strip-shaped guide pieces.

Therefore, it is respectfully suggested that the rejection of independent claim 1 as being anticipated by Ferenc is overcome. Reconsideration and withdrawal of the rejection of claim 1 is respectfully requested.

Dependent claims 4-8, being dependent upon and further limiting independent claim 1, should also be allowable for that reason, as well as for the additional recitations they contain. Reconsideration and withdrawal of the rejection of claims 4-8 are respectfully requested.

To further prosecution of the application, the Applicant will now present arguments regarding new claims 18-20. New claim 18 includes "wherein the guide pieces are located at intervals in the longitudinal direction of the chain sliding face". In Ferenc, there is a long exterior guide surface 34 on one side of the body. Ferenc may also disclose two smaller guide surfaces, on the ends of the other side of the body. However, Ferenc does not disclose guide pieces located at intervals in the longitudinal direction of the chain sliding face. Claim 18 should therefore be allowable over Ferenc.

New claim 19 includes "wherein the guide pieces maintain a flexibility of the blade shoe". Ferenc discloses a single long guide surface 34 on one side of the body. As explained in the present application, "if the guide is provided along the entire length of the blade shoe, the blade shoe cannot change to a suitable curvature radius corresponding to the slacking of the chain when the occasion requires it because the blade shoe becomes difficult to bend and an appropriate tension cannot be applied to the chain at all times" (present application page 2, lines 16-19). Therefore, Ferenc does not disclose guide pieces that maintain a flexibility of the blade shoe. Claim 19 should therefore be allowable over Ferenc.

New claim 20 includes “wherein a space between each two guide pieces is wider than a width of each guide piece”. Ferenc discloses a single guide surface 34 on one side of the body. Clearly, there is no space between two guide pieces here. Claim 20 should therefore be allowable over Ferenc.

Rejections under 35 U.S.C. §103

5. Claims 2 and 3 were rejected under 35 U.S.C. 103(a) as being unpatentable over Ferenc *et al.* in view of Mott *et al.* (5,779,582). Applicant respectfully disagrees with this rejection. The argument regarding the anticipation of claim 1, upon which claims 2 and 3 depend, is herein repeated by reference.

Regarding claim 1, upon which claims 2 and 3 depend, Ferenc does not teach or suggest a plurality of solitary strip-shaped guide pieces upraised from a side edge portion of the chain sliding face having flat faces, wherein the guide pieces are located along the chain sliding face and the flat faces of the guide pieces come in contact with and guide the chain (emphasis added).

Mott *et al.* do not provide what Ferenc lacks. Mott *et al.* do not teach or suggest a plurality of solitary strip-shaped guide pieces having flat faces that come into contact with and guide the chain. Instead, the chain guide of Mott *et al.* “is constructed with raised side rails that taper inward to the center” (Abstract). The Examiner asserts that Mott *et al.* show a plurality of guide pieces, and points to Fig. 13 to support his assertion. Fig. 13 is described very briefly in the specification. “Fig. 12 and Fig. 13 illustrate alternate embodiments of the chain guide of the present invention designed to prevent a plurality of vibrational modes.... Fig. 13 is designed to prevent the third order vibrational mode. In addition, the chain guide can be designed with more tapered segments to prevent even higher vibrational modes.” (col. 5, lines 24-30). Although the rail may be very thin in some places in Fig. 13, Fig. 13 shows a single rail with very thin portions. The rails go all the way across, but narrow significantly in multiple places. See also paragraphs 12-15 of the Ledvina declaration.

Both Fig. 13 and the accompanying description discuss tapered segments of the one piece chain guide, which covers a substantial portion of the tight side of the chain, as shown in Figure

2 of Mott *et al.* These tapered side rails of the one piece chain guide are not a plurality of solitary guide pieces; they are single side rails that taper at certain locations.

Even assuming that there is a plurality of solitary guide pieces taught or suggested in Mott (which the Applicant does not concede), the guide pieces are not strip-shaped, nor do they have flat faces. Therefore, Mott *et al.* do not teach that component of the claim.

Neither Ferenc nor Mott, alone or in combination, teach or suggest claim 1. Therefore, claim 1 is not obvious over these references.

Claims 2 and 3, being dependent upon and further limiting claim 1, should also be allowable for that reason, as well as for the additional recitations they contain. Reconsideration and withdrawal of the rejection of claims 2 and 3 is respectfully requested.

6. Claims 9-15 were rejected under 35 U.S.C. 103(a) as being unpatentable over Ferenc *et al.* in view of Mott *et al.* (5,779,582). Applicant respectfully disagrees with this rejection.

Claim 9 includes, in part, "ii) a first plurality of solitary guide pieces upraised from a right side edge portion of the chain sliding face and having flat faces, wherein the first guide pieces are located along the chain sliding face and the flat faces of the first guide pieces come in contact with and guide the chain; [and] iii) a second plurality of solitary guide pieces upraised from a left side edge portion of the chain sliding face and having flat faces, wherein the second guide pieces are located along the chain sliding face and the flat faces of the second guide pieces come in contact with and guide the chain." (emphasis added)

Assuming that there are end guide surfaces shown in Fig. 8 (which the Applicant does not concede), Ferenc discloses a single guide surface 34 on one side of the body, and two end guide surfaces on the other side of the body. Ferenc does not disclose a first plurality of solitary guide pieces upraised from a right side edge portion of the chain sliding face having flat faces, and a second plurality of solitary guide pieces upraised from a left side edge portion of the chain sliding face having flat faces.

Mott do not provide what Ferenc lacks. Mott *et al.* do not teach or suggest a first and second plurality of solitary guide pieces having flat faces that come into contact with and guide the chain. Instead, the chain guide of Mott *et al.* "is constructed with raised side rails that taper inward to the center" (Abstract). The Examiner asserts that Mott *et al.* show a plurality of guide pieces, and points to Fig. 13 to support his assertion. Fig. 13 shows a top view of the chain guide. Fig. 13 is described very briefly in the specification. "Fig. 12 and Fig. 13 illustrate alternate embodiments of the chain guide of the present invention designed to prevent a plurality of vibrational modes.... Fig. 13 is designed to prevent the third order vibrational mode. In addition, the chain guide can be designed with more tapered segments to prevent even higher vibrational modes." (col. 5, lines 24-30). Although the rail may be very thin in some places in Fig. 13, Fig. 13 shows a single rail with very thin portions. The rails go all the way across, but narrow significantly in multiple places. These differences are also explained in paragraphs 12-15 of the Ledvina declaration.

Both Fig. 13 and the accompanying description discuss tapered segments of the one piece chain guide, which covers a substantial portion of the tight side of the chain, as shown in Figure 2 of Mott *et al.* These tapered side rails of the one piece chain guide are not a plurality of solitary guide pieces; they are single side rails that taper at certain locations. There is a single rail on each side of the chain sliding face.

Neither Ferenc nor Mott, alone or in combination, teach or suggest claim 9. Therefore, claim 9 is not obvious over these references. Reconsideration and withdrawal of the rejection of claim 9 is respectfully requested.

Claims 10-17 and 21-24, being dependent upon and further limiting claim 9, should also be allowable for that reason, as well as for the additional recitations they contain. Reconsideration and withdrawal of the rejection of claims 10-15 is respectfully requested.

To further prosecution of the application, the Applicant will now present arguments regarding new claims 21-24. New claim 21 includes "wherein the first plurality of guide pieces are located at intervals in the longitudinal direction of the chain sliding face". In Ferenc, there is a long exterior guide surface 34 on one side of the body. Ferenc may also disclose two smaller guide surfaces, on the ends of the other side of the body. However, Ferenc does not teach or suggest a first plurality of guide pieces located at intervals in the longitudinal direction of the chain sliding face.

Regarding claim 21, Mott *et al.* do not provide what Ferenc lacks. Mott *et al.* teach a single guide rail with tapered segments. Mott does not teach or suggest a first plurality of guide pieces located at intervals in the longitudinal direction of the chain sliding face. Therefore, claim 21 is not obvious over Ferenc and Mott, alone or in combination.

New claim 22 includes "wherein the second plurality of guide pieces are located at intervals in the longitudinal direction of the chain sliding face". In Ferenc, there is a long exterior guide surface 34 on one side of the body. Ferenc may also disclose two smaller guide surfaces, on the ends of the other side of the body. However, Ferenc does not teach or suggest a first plurality of guide pieces located at intervals in the longitudinal direction of the chain sliding face and a second plurality of guide pieces located at intervals in the longitudinal direction of the chain sliding face.

Regarding claim 22, Mott *et al.* do not provide what Ferenc lacks. Mott *et al.* teach a single guide rail with tapered segments. Mott *et al.* do not teach or suggest a first plurality of guide pieces located at intervals in the longitudinal direction of the chain sliding face or a second plurality of guide pieces located at intervals in the longitudinal direction of the chain sliding face. See also paragraphs 6-11 of the Ledvina declaration. Therefore, claim 22 is not obvious over Ferenc and Mott, alone or in combination.

New claim 23 includes "wherein the guide pieces maintain a flexibility of the blade shoe". Ferenc teaches a single long guide surface 34 on one side of the body and Mott *et al.* teach long tapered guide rails on both sides of the body. As explained in the present application, "if the guide is provided along the entire length of the blade shoe, the blade shoe cannot change to a suitable curvature radius corresponding to the slacking of the chain when the occasion requires it because the blade shoe becomes difficult to bend and an appropriate tension cannot be applied to the chain at all times" (present application page 2, lines 16-19). Therefore, Ferenc and Mott, alone or in combination, do not teach guide pieces that maintain a flexibility of the blade shoe. Claim 23 should therefore be allowable over Ferenc and Mott. See also paragraph 16 of the Ledvina declaration.

New claim 24 includes "wherein a space between each two guide pieces is wider than a width of each guide piece". Ferenc discloses a single guide surface 34 on one side of the body.

Mott *et al.* teach a guide rail with tapered segments that is present along most of the chain sliding face. Therefore, claim 24 is not obvious over Ferenc and Mott, alone or in combination.

Conclusion

Applicant believes the claims, as amended, are patentable over the prior art, and that this case is now in condition for allowance of all claims therein. Such action is thus respectfully requested. If the Examiner disagrees, or believes for any other reason that direct contact with Applicants' attorney would advance the prosecution of the case to finality, he is invited to telephone the undersigned at the number given below.

"Recognizing that Internet communications are not secured, I hereby authorize the PTO to communicate with me concerning any subject matter of this application by electronic mail. I understand that a copy of these communications will be made of record in the application file."

Respectfully Submitted:
Takeda

By:__________/lmw #53791/__________________
Lynda M. Wood, Reg. No. 53,791
Agent for Applicant

BROWN & MICHAELS, P.C.
400 M&T Bank Building - 118 N. Tioga St.
Ithaca, NY 14850
(607) 256-2000 • (607) 256-3628 (fax)
e-mail: docket@bpmlegal.com
Dated: August 4, 2006